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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,576	01/16/2001	Michael Trenk	P/2167-250	2902

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/760,576	Applicant(s) TRENK ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 2/27/2006.

Response to Amendment

2. Claims 1 has have been amended. Claims 1-26 are currently pending. This office action is a non-final action.

Response to Arguments

3. Applicant's arguments filed 2/27/06 concerning 35 USC 112(second) and 35 USC 101 rejections have been fully considered but they are not persuasive. See full explanation provided below.

Claim Rejections - 35 USC § 101

4. Claims 9-18 and 26 are rejected 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 9-18: The applicant states that the claims recite “fully-functional” limitations because the obligations are functions. The applicant further asserts that an obligation functions to establish rights and responsibilities and that the trusts are “highly functional” entities “which can serve to fund a multitude of endeavors, processes and patentable material.”

The examiner disagrees with this assessment of the claimed invention in light of the 35 USC 101, which establishes the class of patentable statutory subject matter (process, machine, manufacture, or composition of matter). The claimed invention is a business document, a contractual arrangement that comprises a plurality of terms and conditions (obligations) and a trust. When view in light of the specification, the contractual arrangement does not fall into any of the aforementioned statutory classes. Therefore, it is maintained that claims 9-18 recite non-statutory subject matter and therefore, not patentable under 35 USC 101. The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. In the instance case, since, the claimed invention is directed to an abstract idea since it cannot produce useful concrete and tangible result as explained below.

6. A further requirement under 35 USC 101 consistent with the aforementioned statutory requirement is that the claimed invention must produce a useful, tangible and concrete result (see State Street and Lundgren previously cited). A document such as the contractual agreement of the subject claim(s) is a mere arrangement of terms and conditions (recited herein as a plurality of obligations and a trust) as a non-functional data structure. Such document is not capable of performing any act or function but merely stipulates which functions and obligations are to be performed by the underlying parties.

7. Claim 26 recites limitation “securitizing cash flow, wherein the cash flow is derived from a future obligation..”. The claim does not recite specifics of the securitizing process, i.e.

securitizing may be accomplished by in one of a plurality of ways. Furthermore, the claim does not positively recite any tangible process (such as transfer of money etc.). Securitizing is interpreted as securing interest in the cash flow by creation of agreement and therefore, the claim does not specify specific steps to achieve the securitizing and therefore covers each and every possible ways the securitizing may be accomplished. In other words the claim also fails to produce a concrete result. Therefore, the claim as a whole fails to produce any concrete and tangible result.

The claim therefore fails to produce concrete, tangible and useful result and therefore interpreted as non-statutory subject matter under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

8. Claims 1-8 and 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites limitation “selling, by a first party, assets to a second party”. The claim fails to establish relationship of this limitation to any other step. Although, the limitation recites same entities (the first party and the second party) which are referred to in other limitations of the claim, it appears that all other limitations are independent and the processes in these steps are performed regardless of the selling step.

Claim 1, furthermore, recites limitations “obligating the first-party-with a first obligation to purchase goods/services from the second party using first money”, “obligating the second party with a second obligation to give a third party a portion of the first money received from the first party” and goods/services from the second party using first money”, and “obligating the third party with a third obligation to give the trust a portion of the first money received from the second party”. The claim, however, fails to specifically recite that the act underlying each of the obligating steps indeed occurs. Mere reciting obligating a first party to perform a certain act in relation to a second party causes the claim to be indefinite because that act may or may not be performed by the obliged party. For example, the first party may not purchase goods/services from the second party using the first money and therefore, the second party will not receive the first money from the first party. (Ditto for other obligating steps.)

The claim 1 refers to “a portion” in two occasions in each of the respective obligating steps. Are these same portions? It is suggested that the claim distinguish these as “a first portion” and “a second portion respectively to make a clear distinction.

The claim 1 is also indefinite due to recitation of step “allowing the third party..” The act of allowing is indefinite because one cannot ascertain whether the underlying process indeed occurs.

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The examiner suggests that the claim be amended to clearly and positively recite the underlying process in each of the obligating steps and the allowing step.

Dependent claims 2-8 also inherit these defects.

Claims 19-25 recites limitations “obligating” and “allowing” in a similar manner as claim 1. Analysis similar to claim 1 is also applicable to and therefore these claims stand rejected under 35 USC 112 (second) as explained above.

Conclusion

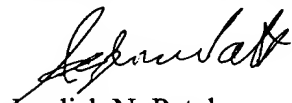
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

5/15/06